

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 2-7, 14, 16-18, and 33-38 are pending in the application. Claims 2-7, 14, 16-18, 33-38 remain unchanged notwithstanding the Examiner's repeated rejections. Non-elected claims 22-32 have been canceled.

First of all, Applicants would like to remind the Examiner that he should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. See MPEP, section 706.07 (emphasis added). Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. See MPEP, section 707.07(f).

The art rejections in the outstanding Office Action are almost identical to the art rejections presented in the previous Office Actions which were traversed by and/or believed overcome by Applicants' numerous arguments and amendments. Even if the Examiner holds Applicants' arguments non-persuasive and/or the amendments insufficient to overcome the rejections, it is still expected that the Examiner would explain the reasons why the rejections are substantively sustained in accordance with proper USPTO practice and procedure. The Examiner's silence makes it very difficult, if at all possible, for Applicants to understand and respond to the Examiner's position as well as to propose further claim amendments, if required.

Accordingly, if any of the rejections manifested in the Office Action, which are respectfully traversed for the reasons advanced below, is to be sustained, the Examiner is requested to specify

the reason(s) why Applicants' arguments are not persuasive and/or why the rejections stand. The **Examiner's cooperation is requested and would be highly appreciated.**

The following supposed errors are found in the outstanding Office Action.

1. The repeated *35 U.S.C. 102(e)* rejection of claim 14 as being anticipated by *Hirtl* is traversed for the reasons advanced in the Amendment filed June 12, 2003 and the October 7, 2003 Request for Reconsideration. The arguments are reproduced below for the Examiner's convenience of review.

The *35 U.S.C. 102(b)* rejection of claim 14 as being anticipated by *Hirtl* is traversed because the reference fails to teach or disclose each and every element of the rejected claims, especially the claimed "resetting mechanism **connecting the barrel and the piston** for automatically resetting the piston from the second forward position to the second rearward position in response to a return movement of the barrel from the first rearward position to the first forward position".

The *Hirtl* reference, including column 4, lines 3-6 cited by the Examiner, does not *expressly* teach or disclose a resetting mechanism connecting the barrel and the piston. Spring 23 of *Hirtl* which the Examiner regarded as part of a resetting mechanism is not described in the patent to connect barrel 4 and piston 6. The *Hirtl* barrel and piston are neither disclosed to be connected by any other means.

The reference does not *inherently* teach or disclose a resetting mechanism connecting the barrel and the piston because the Examiner fails to provide "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added). Thus, the claimed resetting mechanism is not disclosed by *Hirtl* either expressly or inherently.

Also, note the opposite travels of the piston and barrel during resetting, i.e., the piston moves *rearwardly* in response to a *forward* travel of the barrel. The applied references fail to disclose, teach or suggest this unique feature of the claimed invention.

Accordingly, the anticipatory rejection of claim 14 is deemed inappropriate and should be withdrawn.

2. The 35 U.S.C. 102(e) rejection of claim 36 as being anticipated by *Hirtl* is traversed, because the reference fails to teach or disclose the claimed **braking elements for catching and stopping the piston on rebound** after said piston has been reset into the second rearward position by said resetting mechanism, wherein said braking elements are not part of said resetting mechanism and operate independently of said resetting mechanism.

The Examiner reads elements 14 and 15 of *Hirtl* on the claimed braking elements. Element 14 of *Hirtl* is an entrainment stud of entrainment device 15. As can be seen in the figure of *Hirtl*, elements 14 and 15 are disposed behind piston 6 and are moved by the piston *rearwardly* upon cocking. See column 3, lines 8-10 and 32-36. However, elements 14 and 15 do not have any effect on the piston upon rebound which is a *forward* movement.

Accordingly, Applicants respectfully submit that the anticipatory rejection of claim 36 is deemed inappropriate and should be withdrawn.

3. The 35 U.S.C. 103(a) rejection of claims 2-7, 16-18, 33-35 and 37-38 as being unpatentable over *Hirtl* in view of *Jochum* is traversed for the reasons advanced in the October 7, 2003 Request for Reconsideration. The arguments are reproduced below for the Examiner's convenience of review.

The 35 U.S.C. 103(a) rejection of claims 2-7 and 16-18 as being unpatentable over *Hirtl* in view of *Jochum* is traversed because the applied references singly or in combination fail to disclose, teach or suggest all limitations of the rejected claims.

The Examiner appeared to admit that *Hirtl* does not teach or suggest the last two limitations of independent claim 2, i.e., engagement means and displacement means. The Examiner then stated that *Jochum* teaches the missing elements and held it would have been obvious to combine *Jochum* with *Hirtl* to provide for a gripping means for arresting returning the piston.

Applicants respectfully disagree, because *Hirtl* and *Jochum* do not disclose, teach or suggest the claimed **displacement means for displacing the engagement means rearwardly** and comprising an **energy source**. Contrary to the Examiner's position manifested in page 3, line 7 from bottom of the Office Action, element 10 of *Jochum* is a ball (*see* Fig. 1, column 5, line 33 of *Jochum*) rather than an energy source. The assembly ball 10/pad 11 of *Jochum* which the Examiner regarded as the claimed engagement means is not displaced rearwardly by any means. The assembly ball 10/pad 11 of *Jochum* is deemed to be mounted stationary. Thus, *Hirtl* in view of *Jochum*, as applied by the Examiner, fail to render the invention of claim 2 obvious.

4. Claims 3-7 and 33-35 are patentable at least for the reasons advanced with respect to independent claim 2. Claims 16-18 and 37-38 are patentable at least for the reasons advanced with respect to independent claim 14. The dependent claims are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art for the reasons advanced in the Rule 114 Submission filed December 8, 2003. The reasons are reproduced below for the Examiner's convenience of review.

As to claim 16, the applied references fail to disclose, teach or suggest a **spring attached to the barrel and the catching element**. The Examiner's catching element appears to be assembly 10/11 of *Jochum*. This assembly is not disclosed or suggested to be attached to any spring.

As to claim 17, the applied references fail to disclose, teach or suggest the claimed **latch**. The Examiner did not specify where in the applied references this claim feature might be found or suggested. Clarification is respectfully requested.

As to claim 33, the applied art of record fails to disclose, teach or suggest that said **engagement means are moveable relative to the forward end of said barrel assembly**. See, e.g., the relative positions of elements 22 and 8a in FIGs. 1 and 2 of the instant application. In *Jochum*, elements 10, 11 are fixed to barrel 8. See Figs. 1-3 of *Jochum*.

As to claim 34, the applied art of record fails to disclose, teach or suggest that said **engagement means are connected to said forward end of said barrel assembly by a spring other than the energy source**. See, e.g., element 29 in FIGs. 1 and 2 of the instant application.

As to claim 35, the applied art of record fails to disclose, teach or suggest **braking means different from said engagement means**. See, e.g., elements 26 and 22/24 in FIGs. 1 and 2 of the instant application. The Examiner's combined device includes, at best, only breaking elements 10/11 of *Jochum*.

As to claim 36, the applied art of record fails to disclose, teach or suggest **braking elements which are not part of said resetting mechanism and operate independently of said resetting mechanism**. See, e.g., elements 26 and 22/24 in FIGs. 1 and 2 of the instant application. The Examiner's combined device includes, at best, only breaking elements 10/11 of *Jochum*.

As to claim 37, the applied art of record fails to disclose, teach or suggest that **said barrel comprises a front portion being connected to said catching element which is connected to an end of said spring which has an opposite end connected to a rear portion of said barrel**. See, e.g., elements 8a, 22/24, 32, 8b in FIGs. 1 and 2 of the instant application.

As to claim 38, the applied art of record fails to disclose, teach or suggest **another spring**

disposed between and connecting said front portion and said catching element. See, e.g., element 29 in FIGs. 1 and 2 of the instant application.

Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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